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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/647,505 | 08/26/2003 | Anthony Sgroi JR. | 618-1170-999 | 2713 |

20582 7590 10/04/2004

JONES DAY
51 Louisiana Avenue, N.W
WASHINGTON, DC 20001-2113

EXAMINER

BASICHAS, ALFRED

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
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3749

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/647,505

Applicant(s)

SGROI ET AL.

Examiner

Alfred Basichas

Art Unit

3749

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/16/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. The species election requirement of the previous office action is hereby withdrawn. Further review and consideration has revealed that the various species are not patentably distinct.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-75 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-41 of U.S. Patent No. 6,726,469. Although the conflicting claims are not identical, they are not patentably distinct from each other because the general scope of the invention claimed are the same. The general scope of the claims involves an actuator with plural positions corresponding to plural force/pressure required to ignite the fuel. Whether the claims

simply recite varying the force/pressure required between the positions of the actuator, whether the claims specifically recite a high and low pressure mode, or whether the claims recite a specific amount of force required, the differences would not be unobvious to one of ordinary skill in the art at the time of invention.

4. Claims 1-75 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-52 of U.S. Patent No. 6,491,515. Although the conflicting claims are not identical, they are not patentably distinct from each other because the general scope of the invention claimed are the same. The general scope of the claims involves an actuator with plural positions corresponding to plural force/pressure required to ignite the fuel. Whether the claims simply recite varying the force/pressure required between the positions of the actuator, whether the claims specifically recite a high and low pressure mode, or whether the claims recite a specific amount of force required, the differences would not be unobvious to one of ordinary skill in the art at the time of invention.

5. Claims 1-75 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-52 of U.S. Patent No. 6,488,492. Although the conflicting claims are not identical, they are not patentably distinct from each other because the general scope of the invention claimed are the same. The general scope of the claims involves an actuator with plural positions corresponding to plural force/pressure required to ignite the fuel. Whether the claims simply recite varying the force/pressure required between the positions of the actuator, whether the claims specifically recite a high and low pressure mode, or whether the

Art Unit: 3749

claims recite a specific amount of force required, the differences would not be unobvious to one of ordinary skill in the art at the time of invention.

6. Claims 1-75 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of copending Application No. 10/788,195. Although the conflicting claims are not identical, they are not patentably distinct from each other because the general scope of the invention claimed are the same. The general scope of the claims involves an actuator with plural positions corresponding to plural force/pressure required to ignite the fuel. Whether the claims simply recite varying the force/pressure required between the positions of the actuator, whether the claims specifically recite a high and low pressure mode, or whether the claims recite a specific amount of force required, the differences would not be unobvious to one of ordinary skill in the art at the time of invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 1-75 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-69 of copending Application No. 10/398,975. Although the conflicting claims are not identical, they are not patentably distinct from each other because the general scope of the invention claimed are the same. The general scope of the claims involves an actuator with plural positions corresponding to plural force/pressure required to ignite the fuel. Whether the claims simply recite varying the force/pressure required between the positions of the actuator, whether the claims specifically recite a high and low pressure

Art Unit: 3749

mode, or whether the claims recite a specific amount of force required, the differences would not be unobvious to one of ordinary skill in the art at the time of invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alfred Basicas whose telephone number is 703 306 3476. The examiner can normally be reached on Monday through Friday during regular business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ira Lazarus can be reached on 703 308 1935. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0861.

September 30, 2004


Alfred Basicas
Primary Examiner
703 306 3476